

**REMARKS**

This paper responds to the most recent Office action. As the Examiner will appreciate, the subject matter of each of dependent claim 6, 13 and 20 (i.e., “by comparing the state information about the set of authorized resources against a configurable rule associated with one or more resources in the set of authorized resources”) has been incorporated into each independent claim to further distinguish the invention over the cited art. A “configurable rule” is referred to in the specification as an “entitlement rule.” This subject matter is described, for example, in paragraphs [0043] and [0049]-[0050], with emphasis supplied:

[0043] With reference now to FIG. 3, a flowchart depicts a process for creating a set of entitlement rules that control an entitlement server in accordance with an embodiment of the present invention. The process begins with an administrative user or some other type of user with special server-side privileges operating an entitlement rule management application (step 302), such as is shown in FIG. 2. The administrator selects a resource to be restricted through the management application (step 304). The resource may be selected from a list of computational resources within the server-side computational environment as presented to the administrator by the management application. The list of computational resources that are restrictable through the management application may also be configured through the management application. The administrator then selects or enters a utilization or availability threshold value to be associated with the selected resource (step 306). An entitlement rule is then generated (step 308), and the newly generated entitlement rule is stored in association with an indication of the selected resource (step 310), thereby concluding the process.

[0049] The values of variables within the current entitlement rule are retrieved (step 460), and the entitlement rule is evaluated based on the retrieved variable values (step 462). The values may be retrieved from user attributes that are stored in a user registry, from a server status information database, or some other type of datastore.

[0050] A determination is then made as to whether or not the entitlement rule evaluates to an assertion that the current authorized resource should be regarded as over-utilized or unavailable (step 464). If so, then the authorized resource is removed from the list of authorized resources (step 466); in this manner, the list of authorized resources is possibly reduced entry-by-entry. A determination is then made as to whether or not there are any authorized resources in the list of authorized resources that remain unprocessed (step 468). If not, then the processed list of zero or more remaining authorized resources now represents the list of zero or more entitled resources that is returned to the calling function (step 470), and the process is concluded.

In reviewing the most recent Office action, it was noted that the Examiner did not provide any reasons or arguments as to the specific subject matter of dependent claim 6, 13 or 20 (which

subject matter is now in the amended independent claims). Under 37 CFR §1.104(b), an Office action must be complete as to all matters; moreover, under Rule 1.104(c), the “pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Here, the Examiner has not identified how this function is present in the cited reference (it is not). For this reason alone, independent claims 1, 8 and 15 should be found to be in allowable condition.

**Alleged non-statutory subject matter**

Claims 15-17 and 19-21 are rejected under 35 USC § 101 as directed to non-statutory subject matter because the “computer readable medium covers encoded signals.” Respectfully, this rejection is traversed.

The preamble of each such claim recites a “computer program product in a computer readable medium,” and such a medium is a “manufacture” within the meaning of 35 U.S.C. §101. Moreover, the specification (at page 29, lines 10-11) provides several examples of such a manufacture in the form of “EPROM, ROM, tape, paper, floppy disc, hard disk drive, RAM, and CD-ROMs.” The Examiner has cited no Patent Law, Patent Office Rule or MPEP section that stands for the proposition that inclusion of “transmission-type media” (in the list, at line 12) renders these other media types non-statutory. This is not a case where the only “media” listed is “transmission-type media.” Rather, the list of media includes what are unquestionably a set of known physical media (e.g., EPROM, ROM, etc.). If the Examiner believes that the specification must be amended to remove “transmission-type media” in order for the Applicants to be entitled to claim a “computer program product in a computer readable medium,” the Examiner is requested to state that position on the record and to provide the legal or other support for it.

Claims 8-10 and 12-14 also are rejected under 35 USC § 101 as directed to “software per se.” In the first instance, this new rejection is untimely. The Examiner has ample opportunity to raise this rejection during the two prior Office actions (on November 1, 2006, and May 11, 2007) but did not do so. With respect to the subject matter at issue here (an “apparatus” with various “means plus function” clauses), these claims have never been changed since their original submission. The Office practice (MPEP 707.07(g)) is clear that the Examiner should avoid “piecemeal examination,” and rejection of these claims on the basis that there are not statutory raises a new issue that violates the Office’s practice in this regard. Moreover, and with all due

respect, the Examiner is incorrect that these claims are non-statutory. Section 101 describes patentable subject matter to include “any new and useful … machine.” The specification (e.g., at paragraphs [0023]-[0026], among other places) describes an embodiment of that “machine” here as comprising a “data processing system” that includes appropriate hardware, as well as software for carrying out the recited functions. Of course, 35 USC § 112(6) allows an applicant to claim his or her invention using “means plus function”-style claiming. A statutory “machine” – even one described as a “data processing system” – need not recite “processor” or “memory” elements to satisfy the requirements of §101. Further, even if the recited subject matter were in fact just “software,” this (in of itself) does not foreclose its protection as an “apparatus” having a set of MPF-style elements. If that were the case, an applicant could never obtain a patent on a computer executing software. This is not the Office’s current practice, and it is not the Law. The “apparatus” recited in claims 8-10 and 12-14 is clearly statutory subject matter, and the Examiner’s rejection to the contrary is untimely and in error.

#### **Alleged indefinite subject matter**

Claims 8-10 and 12-14 are rejected under 35 USC § 112 as being indefinite because it “is not clear what the corresponding structures for the means-plus-function claimed limitations are.” This rejection is traversed.

Under current Federal Circuit precedent, as exemplified by Biomedino, LLC v. Waters Techs. Corp., 490 F. 3d 946 (Fed. Cir. 2007), “[w]hile the specification must contain structure linked to claimed means, this is not a high bar: “[a]ll one needs to do in order to obtain the benefit of [§ 112, ¶ 6] is to recite some structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of [§ 112,] ¶ 2.” (See, in particular, Atmel Corp. v. Info. Storage Devices, Inc., 198 F.3d 1374, 1382 (Fed. Cir. 1999)). In contrast, only “[i]f there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claim will be found invalid as indefinite. See Atmel, 198 F.3d at 1378-79 (citing In re Donaldson, 16 F.3d 1189, 1195 (Fed. Cir. 1994)(en banc).

As noted above, a representative “apparatus” is clearly described as a “data processing system” in paragraphs [0023]-[0026] of the specification. This is all that the Patent Law, the Office Rules and the MPEP require.

This rejection should be withdrawn.

**Alleged anticipation**

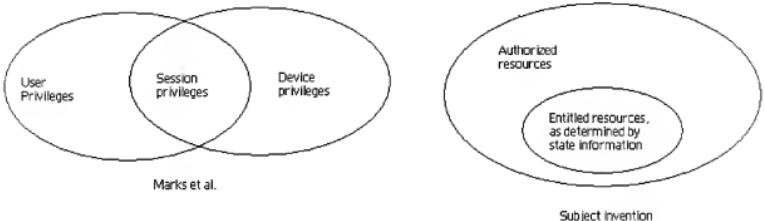
Claims 1-3, 12-17 and 19-21 are rejected under 35 USC § 102(b) as being anticipated by Marks et al., U.S. Publication No. 2002/0010768. Respectfully, and for the reasons advanced in response to the prior Office action and as set forth below, this rejection is traversed. Nevertheless, in an effort to advance this prosecution, the “evaluating availability of the set of authorized resources by comparing the state information about the set of authorized resources against a configurable rule associated with one or more resources in the set of authorized resources” function (from each of dependent claim 6, 13 and 20) has been incorporated into each independent claim.

As previously argued, the subject disclosure concerns “a process for determining a set of resources to be shown to a user that are specifically authorized for the user and that have been specifically entitled for the user based on computational status information about the server-side environment.” [0044]. An advantage of the disclosure is that it “proactively prevents users from obtaining an ability to request certain resources because of the state of the server-side system, even though the user would be authorized to request those resources under different server-side conditions; the user’s entitled resources are always a subset of the user’s normally authorized resources, although the set of entitled resources may be equal to or as extensive as the set of authorized resources.” [0052].

Marks et al manage networked devices to allow tracking and dynamic generation of access privileges across multiple terminals and for multiple registered users. In their system, a user has a set of user privileges that is based on a user profile. The user profile includes the class of the user and a set of user privileges and settings (e.g., application licenses, bookmarks, file access privileges, network access privileges, page access privileges, and the like). The system also has available to it so-called “device privileges,” which are obtained from an “asset database.” A device privilege describes a terminal profile for a given terminal. The terminal profile includes a set of device privileges (e.g., applications available, network connections, and the like). [0047-48]. When an authorized user of the network logs in at a terminal, the user is provided with “session privileges” that are the intersection of the individual user privileges and the device privileges of the device on which the user is logged in. The “user has access to all

resources that the user has rights to, so long as those resources are available (based both on technical availability and usage policy) to the specific terminal being used regardless of the terminal being used and the location of the terminal.” [0017].

The differences between the subject disclosure and Marks et al may be visualized as follows:



As can be seen, in the subject disclosure the resources actually exposed to the user (namely, the “entitled resources”) are a function of the “state” (e.g., the current computational state) of those resources. Each of the subject claims emphasize this feature by requiring the explicit functions of “obtaining state information about the set of authorized resources” and “evaluating availability of the set of authorized resources based upon the state information ...” As now positively recited, this evaluation is performed using a “configurable rule.”

While Marks et al make a passing reference to resources being “available (based both on technical availability and usage policy) to the specific terminal,” this is not an explicit teaching of actively “obtaining state information,” using such state information to evaluate availability of the user-authorized resources, or generating a “list of a set of entitled resources for the user.” At most, Marks et al know (from the terminal profile) the “applications available” or the “network connections” to that terminal. This static configuration appears to be the “technical availability” to which the inventors there refer; a preferred embodiment of the subject disclosure, in contrast, is directed to techniques that are much more active and dynamic. Thus, for example, in a system like Marks et al, a session privilege might well provide the authorized user with access to an application running on the terminal that, in fact, is currently overloaded and cannot provide the required or expected quality of service to the user. This possibility is explicitly foreclosed by each claim, which requires the limitation of “preventing the user from accessing resources that

are in the set of authorized resources but that are not in the set of entitled resources.” Thus, in the subject disclosure, the “state” of such an application (namely, the “application running on the terminal in Marks et al) would be exposed to the system and, as a consequence, the application would be omitted from the “set of entitled resources.” In this manner, the subject disclosure provides a more valuable experience to the end user, whose expectations are not frustrated when trying to access a normally authorized resource that, for system or other reasons, is not then available.

Further, and as noted above, Marks et al do not disclose or suggest any form of “configurable rule” – such as an administrator-defined entitlement rule – by which “state” information should be evaluated. Thus, in addition to the other differences (between the claimed subject matter and the cited reference), the claimed invention thus provides an additional level of control by enabling an administrator (for example) to define what “state” variations should be considered significant enough before the authorized resource is removed “a list of a set of entitled resources for the user.” Marks et al do not provide this level of control; indeed, as noted above, in that system an overloaded resource might well be included in the session privilege.

The Manual of Patent Examining Procedure (MPEP) § 2131 provides that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. ... While literal correspondence is not required, still ‘the identical invention must be shown in as complete detail as contained in the ... claim.’ The elements must be arranged as required by the claim.” (citations omitted, emphasis supplied). Marks et al do not meet this rigid requirement because, as noted above, the reference does not disclose at least the following functions:

“evaluating availability of the set of authorized resources by comparing the state information about the set of authorized resources against a configurable rule associated with one or more resources in the set of authorized resources.”<sup>1</sup>

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<sup>1</sup> Applicants hereby reserve their right to argue (as they have done previously) that Marks et al do not teach the other recited elements of each independent claim.

**The dependent claims are also patentable**

Dependent claims 2, 9 and 16 are each separately patentable because, in addition to not generating a list of entitled resources, Marks et al. do not disclose or suggest “sending an indication of the set of entitled resources to the user.” Figure 5B illustrates an embodiment of this feature.

Dependent claims 3, 10 and 17 are each patentable for the reasons set forth above in connection with the respective parent independent claim.

Dependent claims 5, 12 and 19 are each patentable for the reasons set forth above in connection with the respective parent independent claim.

Likewise, dependent claims 7, 14 and 21 are each separately patentable because Marks et al. do not obtain “state information,” let alone do so using a “distributed monitoring application.”

For the above reasons, the anticipation rejection should be withdrawn.

A Notice of Allowance is requested.

Respectfully submitted,

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